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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,749	02/26/2002	Edward Pinto	PIN01-002P	8454

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EXAMINER

CHOI, JACOB Y

ART UNIT PAPER NUMBER

2875

DATE MAILED: 02/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,749

Applicant(s)

PINTO ET AL.

Examiner

Jacob Y Choi

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 3, 4, 5, 7, 9, 10, 11, 12, & 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Chung (USPN 5,692,828) or Hall et al. (USPN 5,297,013) in view of Shalvi (USPN 6,120,165).

Regarding claim 1, either Chung or Hall et al. disclose a display element (30 or 40) that is removably attached to a support member by an attaching means (442, 433 or column 2-3, lines 65-5 and column 4 lines 3-15), a light bulb (column 1, line 27 or 70) being positioned on the support element (figure 1 or figures 2 & 3) such that the light bulb illuminates the display element, and the support element being *removably* affixed to a surface. Either Chung or Hall et al. discloses the claimed invention except for an electrical power source stored within the support element. Shalvi teaches that it is known to modify outdoor lamp with an electrical power source stored within the support element. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use modification in either Chung or Hall et al., as taught by

Shalvi in order to self-power the outdoor lamp without utilizing long strands of electrical wires that is connected to the power outlet.

Regarding claim 2, either Chung or Hall et al. discloses the claimed invention, in view of Shalvi. In addition, either Chung or Hall et al. discloses the display element has a top region that is *aesthetically* designed and a bottom region that attaches to a top end of the support element via an attaching means.

Note: aesthetic - characterized by a heightened sensitivity to beauty (either Chung or Hall et al. discloses the display element that is appealing to eyes of one). In addition, USPN 4,841,416 – column 5 lines 3-10 or USPN 2,178,454 or USPN 5,597,229 or USPN 5,846,070 may be used against applicant's claimed invention after this Office Action.

Regarding claim 3, either Chung or Hall et al. discloses the claimed invention, in view of Shalvi. In addition, either Chung or Hall et al. discloses the bottom region of the display element is substantially annular and accommodates the top end of the support element in a frictional manner.

Regarding claim 4, either Chung or Hall et al. discloses the claimed invention, in view of Shalvi. In addition, either Chung or Hall et al. discloses the bottom region of the display element has a substantially annular wall, the attaching means being defined by at least an aperture defined through the wall and able to receive a retractable protruding member extending from the support element, whereby, the protruding member extends through the aperture by force from a resilient member in a resting stage and prevents removal of the display element.

Regarding claim 5, either Chung or Hall et al. discloses the claimed invention, in view of Shalvi. In addition, either Chung or Hall et al. discloses the light bulb is positioned on the top end of the support element, a bottom end of the support element being distal to the top end, the support element being tubular in nature such that the bottom end has an opening for frictionally receiving an affixing element therein.

Regarding claim 7, either Chung or Hall et al. discloses the claimed invention, in view of Shalvi. In addition, either Chung or Hall et al. discloses the light bulb is positioned on the top end of the support element, a bottom end of the support element being distal to the top end, the support element being tubular in nature such that the bottom end has an opening for frictionally receiving an upper end of an extending element therein, the extending element having a lower end that is distal to the upper end, the extending element being tubular in nature such that the lower end receives a top boundary of an affixing element therein in a frictional manner, an affixing end of the affixing element being distal to the top boundary and removably attaching to a surface.

Regarding claim 9, either Chung or Hall et al. discloses the claimed invention, in view of Shalvi. In addition, Shalvi clearly discloses the power source is a rechargeable battery that is recharged by a solar cell that is affixed to an outer wall of the support element and is in communication with the rechargeable battery therethrough.

Regarding claim 10, either Chung or Hall et al. discloses the claimed invention, in view of Shalvi. In addition, Shalvi clearly discloses the power source is a rechargeable battery that is recharged by a solar cell that is affixed to an outer wall of the support element and is in communication with the rechargeable battery therethrough.

Regarding claim 11, either Chung or Hall et al. disclose a display element having a top region of an *aesthetic design* and a bottom region having a hole therein, a support element having a top end and a bottom end and the top end being insertable into the hole of the bottom region of the display element in a frictional manner to removably engage the bottom region via an attaching means, and the support element being removably affixed to a surface. Either Chung or Hall et al. discloses the claimed invention except for an electrical power source stored within the support element. Shalvi teaches that it is known to modify outdoor lamp with an electrical power source stored within the support element. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use modification in either Chung or Hall et al., as taught by Shalvi in order to self-power the outdoor lamp without utilizing long strands of electrical wires that is connected to the power outlet.

Note: aesthetic - characterized by a heightened sensitivity to beauty (either Chung or Hall et al. discloses the display element that is appealing to eyes of one). In addition, USPN 4,841,416 – column 5 lines 3-10 or USPN 2,178,454 or USPN 5,597,229 or USPN 5,846,070 may be used against applicant's claimed invention after this Office Action.

Regarding claim 12, either Chung or Hall et al. discloses the claimed invention, in view of Shalvi. In addition, either Chung or Hall et al. discloses the bottom region of the display element has a substantially annular wall, the attaching means being defined by at least an aperture defined through the wall and able to receive a retractable protruding member extending from the support element, whereby, the protruding member extends

through the aperture by a force exerted by a resilient member in a resting stage and prevents removal of the display element.

Regarding claim 18, either Chung or Hall et al. discloses the claimed invention, in view of Shalvi. In addition, Shalvi clearly discloses the power source is obtained from commercially available electricity wired thereto.

3. Claims 6, 8, 13, 14, 15, 16, 17, & 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chung (USPN 5,692,828) or Hall et al. (USPN 5,297,013) in view of Shalvi (USPN 6,120,165) as applied to claim 1, 2, & 5 above, and further in view of either Woodward (USPN 5,012,394) or Cassey (USPN 3,805,055).

Regarding claims 6 & 8, either Chung or Hall et al. discloses the claimed invention, in view of Shalvi except for the affixing element is telescopic in nature, whereby the display element may be presented at differing heights. Either Woodward or Cassey teaches that it is known to modify out-door lamp device with a telescopic affixing element that adjust the heights of the display element. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use modification in either Chung or Hall et al. in view of Shalvi, as taught by either Woodward or Cassey in order to adjust the height of the display element as one might desire.

Regarding claim 13, either Chung or Hall et al. discloses the claimed invention, in view of Shalvi including the light bulb is positioned on the top end of the support element, the support element being tubular in nature such that the bottom end has an

opening for frictionally receiving an affixing element therein. However, either Chung or Hall et al. does not specifically disclose the affixing element being telescopic in nature, whereby the display element may be presented at differing heights. Either Woodward or Cassey teaches that it is known to modify out-door lamp device with a telescopic affixing element that adjust the heights of the display element. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use modification in either Chung or Hall et al. in view of Shalvi, as taught by either Woodward or Cassey in order to adjust the height of the display element as one might desire.

Regarding claim 14, either Chung or Hall et al. discloses the claimed invention, in view of Shalvi including the light bulb is positioned on the top end of the support element, the support element being tubular in nature such that the bottom end has an opening for frictionally receiving an upper end of an extending element therein, the extending element has a lower end that is distal to the upper end, the extending element being tubular in nature such that the lower end receives a top boundary of an affixing element therein in a frictional manner, an affixing end of the affixing element being distal to the top boundary and removably attaching to a surface. However, either Chung or Hall et al. does not specifically disclose the affixing element being telescopic in nature, whereby the display element may be presented at differing heights. Either Woodward or Cassey teaches that it is known to modify out-door lamp device with a telescopic affixing element that adjust the heights of the display element. It would have been obvious to one having ordinary skill in the art at the time the invention was made

to use modification in either Chung or Hall et al. in view of Shalvi, as taught by either Woodward or Cassey in order to adjust the height of the display element as one might desire.

Regarding claim 15, Chung (USPN 5,692,828) or Hall et al. (USPN 5,297,013) in view of Shalvi (USPN 6,120,165) as applied to claims 11, & 14 above, and further in view of either Woodward (USPN 5,012,394) or Cassey (USPN 3,805,055) discloses the claimed invention, explained above. In addition, Shalvi clearly discloses the power source is a rechargeable battery that is recharged by a solar cell that is affixed to an outer wall of the support element and is in communication with the rechargeable battery therethrough.

Regarding claim 16, Chung (USPN 5,692,828) or Hall et al. (USPN 5,297,013) in view of Shalvi (USPN 6,120,165) as applied to claims 11, & 14 above, and further in view of either Woodward (USPN 5,012,394) or Cassey (USPN 3,805,055) discloses the claimed invention, explained above. In addition, either Chung or Hall et al. clearly discloses the display element is manufactured from a translucent polymeric compound.

Regarding claim 17, Chung (USPN 5,692,828) or Hall et al. (USPN 5,297,013) in view of Shalvi (USPN 6,120,165) as applied to claims 11, 14, & 16 above, and further in view of either Woodward (USPN 5,012,394) or Cassey (USPN 3,805,055) discloses the claimed invention, explained above. In addition, either Chung or Hall et al. clearly discloses the translucent polymeric compound is selected from a group consisting of polystyrene and polyethylene. In addition, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the translucent

compound of the display element, since it has been held that to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Regarding claim 19, Chung (USPN 5,692,828) or Hall et al. (USPN 5,297,013) in view of Shalvi (USPN 6,120,165) as applied to claims 11, & 14 above, and further in view of either Woodward (USPN 5,012,394) or Cassey (USPN 3,805,055) discloses the claimed invention, explained above. In addition, either Chung or Hall et al. discloses the affixing element, the extending element, and the support element are manufactured to be impenetrable to liquids.

Note: it is obvious that most outdoor lamps are proof of outdoor weather.

4. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Chung (USPN 5,692,828) or Hall et al. (USPN 5,297,013) in view of Shalvi (USPN 6,120,165) and either Cassey (USPN 3,805,055) or Woodward (USPN 5,012,394).

Regarding claim 20, either Chung or Hall et al. discloses a display element having a top region of an *aesthetic design* and a bottom region having defined by an annular wall such that a hole is defined therein, a support element having a top end and a bottom end and the top end being insertable into the hole of the bottom region of the display element in a frictional manner to removably engage the bottom region via an attaching means, the attaching means being defined by at least an aperture defined through the wall and able to receive a retractable protruding member extending from the support element and, whereby, the protruding member extends through the aperture by a force exerted by a resilient member in a resting stage and prevents removal of the

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display element a light bulb being positioned on the top end of the support element such that the light bulb illuminates the display element, the support element being tubular in nature such that the bottom end has an opening for frictionally receiving an upper end of an extending element therein, the extending element having a lower end that is distal to the upper end, the extending element being tubular in nature such that the lower end receives a top boundary of an affixing element therein in a frictional manner, an affixing end of the affixing element being distal to the top boundary and removably attaching to a surface.

Either Chung or Hall et al. discloses the claimed invention except for an electrical power source stored within the support element & the extending element and the affixing element are telescopic in nature, whereby the display element may be presented at differing heights.

Shalvi teaches that it is known to modify outdoor lamp with an electrical power source stored within the support element. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use modification in either Chung or Hall et al., as taught by Shalvi in order to self-power the outdoor lamp without utilizing long strands of electrical wires that is connected to the power outlet.

Either Woodward or Cassey teaches that it is known to modify out-door lamp device with a telescopic affixing element that adjust the heights of the display element. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use modification in either Chung or Hall et al. in view of Shalvi,

as taught by either Woodward or Cassey in order to adjust the height of the display element as one might desire.

Reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Note: aesthetic - characterized by a heightened sensitivity to beauty (either Chung or Hall et al. discloses the display element that is appealing to eyes of one). In addition, USPN 4,841,416 – column 5 lines 3-10 or USPN 2,178,454 or USPN 5,597,229 or USPN 5,846,070 may be used against applicant's claimed invention after this Office Action.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kim et al. (USPN 5,846,070) – party candle having visually commemorative effect

Plichta et al. (USPN 5,597,229) – multipurpose coupling for connecting decorations to a stake

Lai (USPN 5,178,454) – decorative lamp post

Doss (USPN 4,841,416) – solar charging lamp

Goggia (USPN 5,072,345) – pop-up landscape light

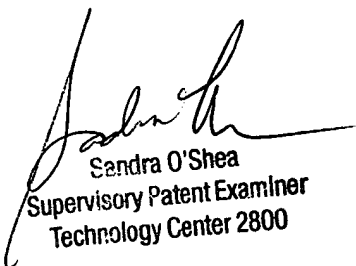
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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacob Y Choi whose telephone number is (703) 308-4792. The examiner can normally be reached on Monday-Friday (10:00-7:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (703) 305-4939. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-7724.

JC
February 5, 2003



Sandra O'Shea
Supervisory Patent Examiner
Technology Center 2800